

ESTTA Tracking number: **ESTTA768532**

Filing date: **09/02/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	3M Company
Granted to Date of previous extension	09/04/2016
Address	2501 Hudson Road, 3M Center St. Paul, MN 55144 UNITED STATES

Attorney information	Christopher Weimer NORTON ROSE FULBRIGHT US LLP 98 San Jacinto Blvd. Suite 1100 Austin, TX 78701 UNITED STATES aoipdock- et@nortonrosefulbright.com,chris.weimer@nortonrosefulbright.com,michael.met teauer@nortonrosefulbright.com,ruth.przygoda@nortonrosefulbright.co Phone:512.474.5201
----------------------	---

Applicant Information

Application No	86698868	Publication date	03/08/2016
Opposition Filing Date	09/02/2016	Opposition Period Ends	09/04/2016
Applicant	The University of Queensland St Lucia Brisbane, QLD 4072, AUSTRALIA		


Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Educational services, namely, conducting educational seminars and educational expositions in the field of academic research; educational services, namely, research in the field of education; educational services, namely, providing training-courses at the postgraduate level; entertainment services in the nature of livepublic speaking performances featuring summaries of higher education thesis materials, academic publications and research; provision of education information, namely, providing summaries of higher education thesis materials and academic publications; publication of posters; all the aforesaid services in association with the organization, arranging and conducting of teaching activities or university education services
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3398329	Application Date	08/16/2007
Registration Date	03/18/2008	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Full line of particulate, ozone, gas, vapor, chemical, biohazard and other respirators, including filtering face-piece respirators and elastomeric face-piece respirators, other than for artificial respiration; full line of self-rescue and protection apparatus, namely, oxygen breathing units, supplied-air respirators, and powered air-purifying systems (PAPRs) respirators; cartridges, filters, air tanks and other component parts for respirators and breathing units; dust masks; full line of protective eyewear, namely, safety goggles, eyeglasses and eye shields; face-protection shields; ear plugs and ear muffs to attenuate sound and protect hearing; hard hats and other protective helmets; welding helmets; air monitoring devices and sensors for measuring gases and vapor concentration levels; gas detectors for detecting the presence of carbon monoxide and other gases; [thermal-imaging cameras for use by firefighters and for search and rescue;] environmental sampling and testing instruments and equipment, namely, electronic luminometers, and related software, docking stations and batteries, for detecting, measuring and analyzing chemicals, biological substances, food residues and microbes; microbiological and contaminant-testing instruments and equipment, and software related thereto, for detecting, measuring and analyzing bacteria, including pathogens such as salmonella and listeria, allergens, toxins, vitamins, antibiotics, and other organisms and substances; diagnostic apparatus for testing food; laboratory equipment and supplies, namely, test tubes, test tube caps, dip sticks, racks, microtitre plates and trays; security scanners and readers for use in reading passports and other forms of identification; anti-theft and library material check-out security systems; radio frequency identification (RFID) tags and readers; [computer software for supply chain management from source to consumption, namely, for collecting, storing and managing data, and reporting, executing and tracking, in connection with enterprise resource planning, supplier enablement, manufacturing, inventory control and warehousing, order fulfillment, shipping, transportation and delivery;] computer software for use in the medical and health care fields for processing claims for reimbursement, maintaining patient and medical records, coding and grouping data used for medical and health care research, and for reporting health trends and other medical data; and medical imaging scanners and related software for capturing images of the mouth and teeth for use in dentistry</p> <p>Class 010. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Full line of surgical and medical masks, respirators and face and eye shields for</p>		

	<p>medical and health-care related personnel; full line of orthopedic castings tapes, splints, reinforcing strips, elastic bandages, and support bandages and compression wraps; composite fabrics containing fiberglass and resins for use in making casts; padding for orthopedic casts; orthopedic casting tools; full line of stethoscopes; full line of surgical masks, face shields, and respiratory masks for medical purposes; full line of surgical and medical procedure drapes and sheets; patient isolation drapes; medical-equipment isolation drapes; non-adherent sheeting for beds, stretchers and exam tables; surgical gowns; compression bandages; surgical compresses; medical thermometers; full line of medical electrodes with or without chemical conductors and wet gels for use in cardiac, electrocardiograph, electroencephalograph and other types of patient monitoring; leads and connectors for use with medical electrodes; defibrillation pads; electrosurgical pads, plates and adapters to remove RF current from a patient's body during electrosurgery; thermal cold and hot packs for first aid and therapeutic purposes; eye patches for medical use; [padding for use between medical equipment and patients or for elevating or positioning limbs;] pouches for holding surgical and medical instruments; [isolation pouches and bags for storing organs, tissue and other body parts for transplants and laboratory testing;] full line of sterilized and non-sterilized fastening and compression surgical wraps; autoclaves for medical use; orthodontic appliances; dental apparatus, namely, intra-oral light systems for curing dental materials, ceramic used in making dental crowns, bridges and other restoratives; dental instruments and kits comprised of such instruments, namely, mandrels, burs, discs, cups, wheels, points, brushes and abrasive strips used to grind, polish or finish dental restoratives; dental instruments, namely, scissors, crimping pliers, contouring pliers and impression trays; electronic mixers for dental compounds; applicators and dispensers for dental primers, cements, adhesives, impression materials and restorative materials; glass-fiber posts used in dental restorative procedures; and dental prophylaxis angles and dental prophylaxis cups for use in cleaning teeth and dental hygiene procedures</p>
--	---

Attachments	<p>77257496#TMSN.png(bytes) Queensland Opposition.pdf(320914 bytes)</p>
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christopher Weimer/
Name	Christopher Weimer
Date	09/02/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No.: 86,698/868
By The University of Queensland for the Mark: 3MT
Filed: July 20, 2015
Published in the *Official Gazette* on March 8, 2016

3M COMPANY,

Opposer,

v.

The University of Queensland,

Applicant,

Opposition No. _____

NOTICE OF OPPOSITION

3M Company (“3M Company” or “3M”), a Delaware corporation having a principal place of business at 3M Center, 2501 Hudson Road, St. Paul, Minnesota, 55144-1000, believes that it will be damaged by registration of the mark in Application Serial No. 86/698,868, and hereby opposes same under the provisions of 15 U.S.C. § 1063.

As grounds for opposition, 3M Company asserts that:

1. 3M Company is the owner of the mark and trade name 3M (collectively the “3M mark”). 3M Company adopted and commenced use of the 3M mark at least as early as 1906, in connection with abrasives, and has continuously used the 3M mark since that time. Over the past century, 3M Company has expanded its usage of the 3M mark and presently offers over 60,000 different products and services under the 3M mark in a wide range of areas.

2. 3M has a long history of involvement in the fields of education and research, particularly at the university level where it has sponsored fellowships for graduate students, faculty awards for university educators, and research grants for numerous universities around the world.

3. The 3M mark is inherently distinctive.
4. 3M has developed an enormous amount of goodwill in its 3M mark. This mark is extremely well-known and respected by consumers. The 3M mark represents 3M's commitment to providing high quality products and services to consumers.
5. As a result of 3M's long use and extensive promotion of the 3M mark, the 3M mark has become distinctive to designate 3M, to distinguish 3M and its products and services from those of others, and to distinguish the source or origin of 3M's products and services. As a result of 3M's efforts, the consuming public throughout the United States widely recognizes and associates the 3M mark with 3M and its products and services.
6. As a result of 3M's long use and extensive promotion of the 3M mark, 3M has acquired valuable common law rights in the 3M mark throughout the United States.
7. As a result of 3M's long use and extensive promotion of the 3M mark and the success of 3M's products and services sold under the 3M mark, the 3M mark has become famous.
8. In accordance with federal law, 3M has registered its 3M mark on the Principal Register of the United States Patent and Trademark Office, and has obtained over 200 trademark registrations for its 3M mark, covering a wide variety of products, including U.S. Registration No. 3,398,329. A true and correct printout from the TSDR database for this registration is attached as Exhibit A. This registration is valid, subsisting, enforceable, and incontestable pursuant to 15 U.S.C. § 1065.
9. Applicant The University of Queensland ("Applicant") seeks to register the mark 3MT ("Applicant's mark") for "Educational services, namely, conducting educational seminars and educational expositions in the field of academic research; educational services, namely, research in the field of education; educational services, namely, providing training courses at the postgraduate level; entertainment services in the nature of live public speaking performances

featuring summaries of higher education thesis materials, academic publications and research; provision of education information, namely, providing summaries of higher education thesis materials and academic publications; publication of posters; all the aforesaid services in association with the organization, arranging and conducting of teaching activities or university education services” in International Class 41 (collectively, “Applicant’s services”).

10. 3M Company’s 3M mark became famous prior to the priority date for Applicant’s application to register Applicant’s mark and Applicant’s use of Applicant’s mark.

11. The mark that Applicant seeks to register so resembles 3M Company’s 3M mark as to be likely, when used on or in connection with Applicant’s services, to cause confusion, or to cause mistake. Purchasers and prospective purchasers are likely to mistakenly believe that the services of Applicant offered under Applicant’s mark are sponsored, endorsed, or approved by 3M Company, or are in some way affiliated, connected, or associated with 3M Company.

12. The mark that Applicant seeks to register so resembles 3M Company’s 3M mark as to be likely, when used on or in connection with Applicant’s services, to dilute the distinctive quality of the 3M mark, in violation of 15 U.S.C. § 1125(c).

13. Registration of Applicant’s mark would be a source of damage to 3M Company because purchasers are likely to attribute the source or sponsorship of Applicant’s services to 3M Company.

14. Registration of Applicant’s mark would be a source of damage to 3M Company because it is likely to dilute the distinctive quality of the 3M mark.

15. Registration of Applicant’s mark would be a source of damage to 3M Company, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of 3M Company’s long prior use of its 3M mark.

WHEREFORE, 3M Company prays that Application Serial No. 86/698,868 be rejected, and that registration of the mark therein be refused under 15 U.S.C. §§ 1052(d), 1063 and 1125(c).

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(17) is being paid electronically via credit card with this Notice of Opposition. The Commissioner of Trademarks is authorized to draw on the deposit account of Norton Rose Fulbright US LLP, Account No. 50-1212/THRE:001/MSM, in the event that anything prevents the successful completion of electronic payment of the filing fee.

Date: September 2, 2016

Respectfully submitted,

/Christopher Weimer/
Christopher Weimer
NORTON ROSE FULBRIGHT US LLP
98 San Jacinto Blvd., Suite 1100
Austin, Texas 78701
Tel: 512.474.5201
Fax: 512.536.4598

ATTORNEYS FOR OPPOSER
3M COMPANY

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Notice of Opposition has been served via First Class Mail to Applicant's Correspondent of Record at the address below on this the 2nd day of September, 2016:

JAMES E. GERINGER
Klarquist Sparkman
121 SW Salmon St Ste 1600
Portland, Oregon 97204-2988

/Ruth Przygoda/
Ruth Przygoda

EXHIBIT A

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.

2. TSDR now displays information regarding [TM5 Common Status Descriptors](#).

STATUS**DOCUMENTS**[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2016-09-02 16:24:19 EDT

Mark: 3M

3M

US Serial Number: 77257496

Application Filing Date: Aug. 16, 2007

US Registration Number: 3398329

Registration Date: Mar. 18, 2008

Register: Principal

Mark Type: Trademark

US Registration Number: 3398329

Registration Date: Mar. 18, 2008

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Apr. 02, 2014

Publication Date: Jan. 01, 2008

▼ Mark Information[▲ Collapse All](#)

Mark Literal Elements: 3M

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Color(s) Claimed: Color is not claimed as a feature of the mark.

▼ Related Properties Information

Claimed Ownership of US Registrations: [1237168](#), [2692036](#), [2793534](#) and others

▼ Goods and Services**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Full line of particulate, ozone, gas, vapor, chemical, biohazard and other respirators, including filtering face-piece respirators and elastomeric face-piece respirators, other than for artificial respiration; full line of self-rescue and protection apparatus, namely, oxygen breathing units, supplied-air respirators, and powered air-purifying systems (PAPRs) respirators; cartridges, filters, air tanks and other component parts for respirators and breathing units; dust masks; full line of protective eyewear, namely, safety goggles, eyeglasses and eye shields; face-protection shields; ear plugs and ear muffs to attenuate sound and protect hearing; hard hats and other protective helmets; welding helmets; air monitoring devices and sensors for measuring gases and vapor concentration levels; gas detectors for detecting the presence of carbon monoxide and other gases; [thermal-imaging cameras for use by firefighters and for search and rescue;] environmental sampling and testing instruments and equipment, namely, electronic luminometers, and related software, docking stations and batteries, for detecting, measuring and analyzing chemicals, biological substances, food residues and microbes; microbiological and contaminant-testing instruments and equipment, and software related thereto, for detecting, measuring and analyzing bacteria, including pathogens such salmonella and listeria, allergens, toxins, vitamins, antibiotics, and other organisms and substances; diagnostic apparatus for testing food; laboratory equipment and supplies, namely, test tubes, test tube caps, dip sticks, racks, microtitre plates and trays; security scanners and readers for use in reading passports and other forms of identification; anti-theft and library material check-out security systems; radio frequency identification (RFID) tags and readers; [computer software for supply chain management from source to consumption, namely, for collecting, storing and managing data, and reporting, executing and tracking, in connection with enterprise resource planning, supplier enablement, manufacturing, inventory control and warehousing, order fulfillment, shipping, transportation and delivery;] computer software for use in the medical and health care fields for processing claims for reimbursement, maintaining patient and medical records, coding and grouping data used for medical and health care research, and for reporting health trends and other medical data; and medical imaging scanners and related software for capturing images of the

for reporting health trends and other medical data, and medical imaging scanners and related software for capturing images of the mouth and teeth for use in dentistry

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: 1960

Use in Commerce: 1960

For: Full line of surgical and medical masks, respirators and face and eye shields for medical and health-care related personnel; full line of orthopedic castings tapes, splints, reinforcing strips, elastic bandages, and support bandages and compression wraps; composite fabrics containing fiberglass and resins for use in making casts; padding for orthopedic casts; orthopedic casting tools; full line of stethoscopes; full line of surgical masks, face shields, and respiratory masks for medical purposes; full line of surgical and medical procedure drapes and sheets; patient isolation drapes; medical-equipment isolation drapes; non-adherent sheeting for beds, stretchers and exam tables; surgical gowns; compression bandages; surgical compresses; medical thermometers; full line of medical electrodes with or without chemical conductors and wet gels for use in cardiac, electrocardiograph, electroencephalograph and other types of patient monitoring; leads and connectors for use with medical electrodes; defibrillation pads; electrosurgical pads, plates and adapters to remove RF current from a patient's body during electrosurgery; thermal cold and hot packs for first aid and therapeutic purposes; eye patches for medical use; [padding for use between medical equipment and patients or for elevating or positioning limbs;] pouches for holding surgical and medical instruments; [isolation pouches and bags for storing organs, tissue and other body parts for transplants and laboratory testing;] full line of sterilized and non-sterilized fastening and compression surgical wraps; autoclaves for medical use; orthodontic appliances; dental apparatus, namely, intra-oral light systems for curing dental materials, ceramic used in making dental crowns, bridges and other restoratives; dental instruments and kits comprised of such instruments, namely, mandrels, burs, discs, cups, wheels, points, brushes and abrasive strips used to grind, polish or finish dental restoratives; dental instruments, namely, scissors, crimping pliers, contouring pliers and impression trays; electronic mixers for dental compounds; applicators and dispensers for dental primers, cements, adhesives, impression materials and restorative materials; glass-fiber posts used in dental restorative procedures; and dental prophylaxis angles and dental prophylaxis cups for use in cleaning teeth and dental hygiene procedures

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: 1960

Use in Commerce: 1960

▼ Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

▼ Current Owner(s) Information

Owner Name: 3M Company

Owner Address: 3M Center, 2501 Hudson Road
St. Paul, MINNESOTA UNITED STATES 55144

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** DELAWARE

▼ Attorney/Correspondence Information

Attorney of Record

Attorney Name: James F. Voegeli

Docket Number: 34775

**Attorney Primary Email
Address:** trademarks@mmm.com

Attorney Email Authorized: Yes

Correspondent

**Correspondent
Name/Address:** James F. Voegeli
3M INNOVATIVE PROPERTIES COMPANY
3M Center, 2501 Hudson Road
220 9E 01
St. Paul, MINNESOTA UNITED STATES 55144

Phone: (651) 736-6989

Fax: (651) 736-3783

Correspondent e-mail: trademarks@mmm.com

Correspondent e-mail Yes

Authorized:

Domestic Representative - Not Found**▼ Prosecution History**

Date	Description	Proceeding Number
Apr. 02, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Apr. 02, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76873
Mar. 14, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	76873
Apr. 02, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76873
Mar. 14, 2014	TEAS SECTION 8 & 15 RECEIVED	
Jul. 15, 2008	NOTICE OF SUIT	
Mar. 18, 2008	REGISTERED-PRINCIPAL REGISTER	
Jan. 01, 2008	PUBLISHED FOR OPPOSITION	
Dec. 12, 2007	NOTICE OF PUBLICATION	
Nov. 26, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	68658
Nov. 26, 2007	ASSIGNED TO LIE	68658
Oct. 22, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 22, 2007	ASSIGNED TO EXAMINER	76509
Aug. 22, 2007	NOTICE OF PSEUDO MARK MAILED	
Aug. 21, 2007	NEW APPLICATION ENTERED IN TRAM	

▼ Maintenance Filings or Post Registration Information**Affidavit of Continued Use:** Section 8 - Accepted**Affidavit of Incontestability:** Section 15 - Accepted**▲ TM Staff and Location Information****▼ Assignment Abstract Of Title Information - Click to Load****▼ Proceedings - Click to Load**

<

>